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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Katsunari Tezuka et al.

Art Unit : 1644

Serial No. : 09/830,548

Examiner : Jessica Roark, Ph.D.

Filed : June 12, 2001

Title : A PHARMACEUTICAL COMPOSITION FOR TREATING IMMUNE DISEASES

Commissioner for Patents
Washington, D.C. 20231RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated November 14, 2002, applicants elect the invention of Group I, drawn to the embodiment of methods of treating inflammation by administering a protein substance that modulates signal transduction by AILIM.

In response to the requirement for election of species, applicants also elect the following: (1) methods of preventing or treating graft versus host reaction or immune rejection accompanying graft versus host reaction or transplantation of a tissue or organ; and (2) an antibody that binds to AILIM. According to the Examiner's species designations, claims 10-15 and 18-22 read on elected species (1) and (2). However, applicants traverse species election requirement (1) for the reasons provided below.

In paragraphs 3 and 8 of the Restriction Requirement, the Examiner asserted that preventing or treating inflammation (claim 10) is generic, and that the following are three species of preventing or treating inflammation: preventing or treating arthrosis (claim 1); preventing or treating immune rejection reaction (claim 18); and preventing or treating an immune response triggered by a foreign antigen or autoantigen (claim 25). According to the Examiner, the specification discloses this genus-species relationship at page 13, lines 8-23.

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December 12, 2002
Date of DepositKathryn Lugo
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Applicants respectfully traverse the requirement for election of species and submit that a method of preventing or treating inflammation is not generic to the methods recited in claims 1, 18, and 25. A “generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.” MPEP § 806.04(d). Although inflammation may frequently accompany the conditions recited in claims 1, 18, and 25, the recited conditions are characterized by varied, complex immune reactions that are not encompassed by the term “inflammation.” Because the methods of claims 1, 18, and 25 do not contain all of the limitations contained in a method of preventing or treating inflammation, the methods of claims 1, 18, and 25 are not species of preventing or treating inflammation. Furthermore, the portion of the specification (page 13, lines 8-23) cited by the Examiner does not establish the proposed genus-species relationship. The cited portion lists several exemplary diseases that are accompanied by inflammation. However, the specification nowhere states that the conditions recited in claims 1, 18, and 25 are merely types of inflammation. Inflammation and the specific conditions recited in independent claims 1, 18, and 25 are disclosed individually in the specification at, e.g., page 12, line 31, to page 13, line 3. In light of these comments, applicants respectfully request that the Examiner withdraw the requirement for election of species.

If the Examiner agrees that species election requirement (1) may be withdrawn in view of the comments provided herein, applicants note that claims 1-7, 10-15, 18-22, and 25-30 read on elected species (2).

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Attorney Docket No. 14539-005001.

Respectfully submitted,

Date: December 12, 2002

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